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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,256	07/03/2003	Gerhard Reichert	1663-AI	4893
7590	11/24/2008		EXAMINER	
Fred H. Zollinger III P.O. Box 2368 North Canton, OH 44720				AMIRI, NAHID
		ART UNIT	PAPER NUMBER	
		3679		
		MAIL DATE	DELIVERY MODE	
		11/24/2008	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/613,256	REICHERT, GERHARD	
	<b>Examiner</b>	<b>Art Unit</b>	
	NAHID AMIRI	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 October 2008.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 70-75 and 94-109 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 70-75 and 94-109 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/02/2008</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed 10/02/2008 in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/23/2007 has been entered. The application is not in condition for allowance in view of the new grounds of rejection set forth below. Claims 1-69 and 76-93 are canceled. Claims 70-75 and 94-109 are pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

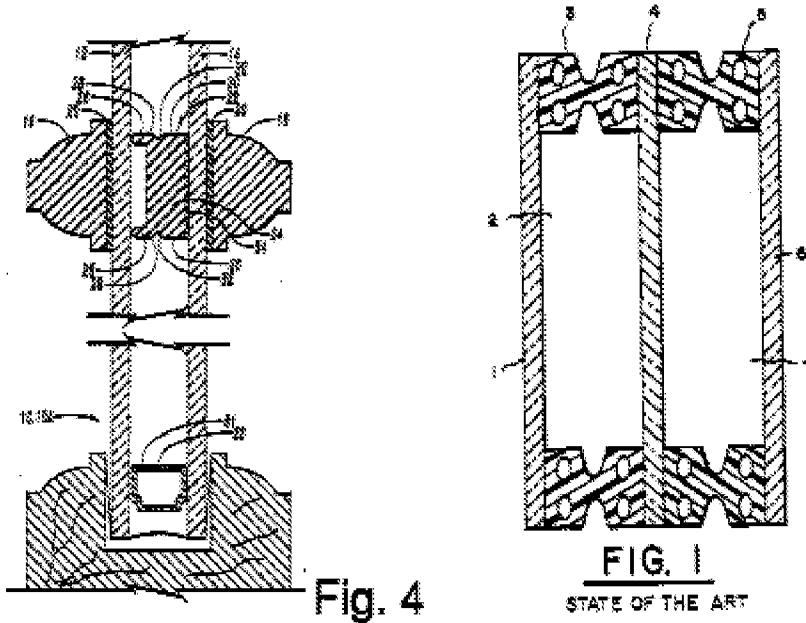
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 62-75, 78-82, and 84-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,345,743 Baier in view of US Patent No. 5,732,517 Milikovsky.**

With respect to claims 62-75, 78-82, and 84-93, Baier discloses a simulated divided lite insulating glazing unit (Fig. 4) comprising first and second spaced glass panes (12, 14) spaced apart by a perimeter spacer (12), the first and second glass panes (12, 14) and spacer (12) defining a gap, a resilient foam internal muntin bar (22) disposed inside the gap which inherently is capable of being rolled into a roll for storage and shipping and then unrolled for application to the glass; the internal muntin bar (22) dividing the gap into separate portions to provide a divided-lite appearance to the glazing unit; the internal muntin bar (22) having a body having a longitudinal direction, the body having opposed base walls (24) separated by the height of the

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body; one of the base walls (24) having an adhesive (34) that connects the base wall (24) to an inner surface of one of the glass panes (14); the base wall having the adhesive (34) defining a body width the body being formed from a body material; and wherein (column 2, lines 60-64) that the body of muntin bar (22) is fabricated from a foam polymer and the foam includes a desiccant. Baier does not disclose the body defining at least one insulating cavity. Milikovsky teaches a window unit (Fig. 2) having glass panes and a spacing elements (3) between glass panes (2 and 4); the spacing elements (3) defining a body (B), the body (B) defining a plurality of insulating cavities (C); wherein the cross section of body material (B) being larger than the cross sectional area of the insulating cavities (C); wherein the body (B) defining a longitudinal direction; and each of the insulating cavity (C) extending continuous in the longitudinal direction; the cavities (C) are spaced apart from one another; and wherein the cavity (C) has a width, the space between the cavities (C) being equal to or greater than the width of either cavity. It would have been obvious to one of ordinary skill in the art at the time of invention was made to provide the muntin bar of Baier with a plurality of insulating cavities as taught by Milikovsky for any of the reasons known in the art. For example, increase the resiliency of the body and/or reduce the effectiveness of the thermal bridge resulting from the muntin bars contacting both sheets of glass.



***Response to Arguments***

Applicant's arguments filed 15 October 2007 have been fully considered but they are not persuasive.

As to claims 62-68, 70-75, 78-82 and 84-93:

Applicant argues that Milikovsky does not disclose or suggest that the body of the spacer with a plurality of insulating cavities or use of cavities; and the relative cross sections of the different portions of the spacer. Further, Applicant submits that an interpretation of unlabeled drawings and unexplained patent drawings cannot be used to properly support a rejection. The conclusion set forth in the Office action that the spacers define openings is a conclusion drawn only with impermissible hindsight drawn from the teachings of Applicant's specification and drawings. This is not persuasive.

As stated in previous Office action mailed on 31 December 2007, the Examiner points out that one is to presume skill on the part of one of ordinary skill in the art, not a lack of skill. *In re Sovish*, 226 US PQ 771 (CCPA 1985). The illustration present in Milikovsky is exactly the same as applicant's illustration of cavities and thus clearly constitute cavities as readily apparent to any person having ordinary skill in the art. Moreover, it is well-established that one of ordinary skill knows something about the art apart from what is explicitly written in a reference document.

Applicant states that the "features" are "unknown to the applicant" and that he would be "speculating" on what these features are. Be that as it may, this does not alter the position advanced by the Examiner and that the interpretation and recognition of such illustrations as "cavities" would be well-within the capability of one of ordinary skill in the art. It is also noted that applicant acknowledges that hollow spacers are known, e.g., see page 13, of the response, line 8. Applicant also states that "longitudinal and continuous" is not a reasonable interpretation of Milikovsky. However, this language cannot be found in claim 62 which merely recites the presence of "at least one open insulating cavity" which is "surrounded by the body". Accordingly, it would appear applicant's remarks are not commensurate with the scope of the claims.

Applicant argues that there is no suggestion or motivation either in the references themselves or in the knowledge generally to combine references. Therefore, the prima facie case of obviousness has not been established. This is not persuasive.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

Applicant argues that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. Therefore, the prima facie case of obviousness has not been established. This is not persuasive. Test of obviousness is what combined teachings would have fairly suggested to one of ordinary skill in the art, *In re Keller*, 208 USPQ 871 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skill in the art would reasonably be expected to draw therefrom, *In re Preda*, 159 USPQ 342 (CCPA 1968). Further, one is to presume skill, not a lack thereof, on the part of one of ordinary skill in the art, *In re Sovish*, 226 USPQ 771 (CAFC 1985). Further, it should also be noted that there is no requirement for motivation be explicitly found in the references themselves, *In re Keller*, supra, and an examiner may find motivation in the nature of the problem to be solved. Nevertheless, Milikovsky clearly teaches use of cavities in spacing elements and the purpose of such cavities is well known to those versed in the art (e.g., reduce effectiveness of thermal bridge).

It is this teaching that is being applied to the muntin bar spacing elements of Baier and this teaching is being applied for the same reasoning known in the art to those of ordinary skill. Whether the particular body is a "muntin bar" or a "spacer" is not seen to be of any difference to the reasoning. Section 103 makes clear that applicant is not entitled to a patent when the differences between the claimed invention and the prior art are obvious.

Further, a *prima facie* case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art, *In re Rinehart* 189 USPQ 143 (CCPA 1976). See also *In re Lalu*, 223 USPQ 1257 (CAFC 1984) and *In re Fine*, 5 USPQ2d 1596 (CAFC 1988).

Further, with respect to Milikovsky, applicant argues that since there is no discussion of what the illustrated feature is, it is improper for the examiner to assume that the feature represents cavities. This is not persuasive. In particular, it is first noted that the illustration of Milikovsky is the same as that used by applicant. Accordingly, how is it that the illustration represents “cavities” when used by applicant, but the same illustration in a prior art reference does not represent “cavities”?

Second, Milikovsky clearly identifies this feature as something that was part of the “state of the art” at least as of 1996 when the application was filed. Being that this feature was part of the state of the art” years before applicant’s instant invention, it certainly is not unreasonable to expect that those of ordinary skill in the art would know what the feature is and why such feature would be present. Applicant makes the allegation that “Nothing in Milikovsky discloses or teaches the use of cavities in the body of the spacer”, e.g., see page 8. No basis for this statement is set forth and the figures of Milikovsky indicate otherwise since cavities are shown in the body of the spacers. Nevertheless, applicant appears to be seeking to present a position that questions the accuracy of the examiner’s stated interpretation of the factual technical information of the “state of the art” acknowledged by Milikovsky. Accordingly, in accordance with 37 CFR 1.105(a)(1)(viii), applicant is required to submit information known to him concerning what the state of the art was and what the illustrated features (identified as cavities by the examiner) are, if not in fact cavities.

The rejections are still deemed to be proper and as such, it would appear that a clear issue has been obtained for review by the Board of Appeals.

### ***Conclusion***

This is a continuation of applicant’s earlier Application No. 10/613,256. All claims are drawn to the same invention claimed in the earlier application and could have been finally

rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nahid Amiri whose telephone number is (571) 272-8113. The examiner can normally be reached on 8:30-5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nahid Amiri  
Examiner  
Art Unit 3679  
November 19, 2008

/Daniel P. Stodola/  
Supervisory Patent Examiner, Art Unit 3679